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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,774	04/06/2001	Thomas R. Gehring	56522USA.002	7350

7590

11/20/2002

Attention: Jeffrey J. Hohenshell
Office of Intellectual Property Counsel
3M Innovative Properties Company
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St. Paul, MN 55133-3427

EXAMINER

MAHONEY, CHRISTOPHER E

ART UNIT

PAPER NUMBER

2851

DATE MAILED: 11/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/827,774

Applicant(s)

GEHRING ET AL.

Examiner

Christopher E Mahoney

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-30 and 32-40 is/are rejected.
- 7) ☒ Claim(s) 31 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> . | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 17 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the applicant has not taught how to make or use a screen which is easy to manually cut so as to customize the size. Furthermore, the applicant is requested to indicate what part of the specification discusses manually cutting the screen.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

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Claims 1, 5-6, 11-12, 14-15, 17-20, 24-30, 32 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by the Hitachi product literature (HPL). HPL discloses a method of displaying information to viewers by providing a projector (CP-X970/CP-X960/CP-S860), providing a flexible screen adhering the screen to a window with optical adhesive, and projecting an image onto the screen.

Claims 9 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Lee (U.S. Patent No. 6,337,769). Lee teaches providing a roll blind type screen in front of a window. The applicant is directed to review figures 7-8 and col. 2, lines 58. The examiner takes Official Notice that blinds are attached by removable mechanical fasteners.

Claim Rejections - 35 USC § 103

Claim 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over HPL. HPL discloses the salient features of the claimed invention except for the step of moving the screen/display. It would have been obvious to one of ordinary skill in the art at the time the invention was made to move the screen for the purpose of preventing consumers from becoming accustomed to the display. If the display stays in one place, consumers will become used to the display and will be more inclined to ignore it. By moving the display it is more likely to be noticed and would therefore be more effective advertising.

Claims 4, 7-8, 13, 16 33-37, and 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over HPL in view of Vance (U.S. Patent No. 5,563,738) or Seki (U.S. Patent No. 3,510,197). HPL discloses the salient features of the claimed invention except for a non-

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holographic or beaded screen. Both Vance and Seki teach that it was known to produce non holographic/beaded screens. It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the features as taught by Vance or Seki for the purpose of gain control.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over HPL in view of Burger (U.S. Patent No. 4,095,013) or Mascarenhas (U.S. Patent No. 6,171,681). HPL discloses the salient features of the claimed invention except for a cling material. Both Burger and Mascarenhas teach that it was known to produce non holographic/beaded screens. It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the features as taught by Burger or Mascarenhas for the purpose of simplifying removal and reuse.

Claims 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (U.S. Patent No. 6,337,769) in view of Vance (U.S. Patent No. 5,563,738) or Seki (U.S. Patent No. 3,510,197). Lee discloses the salient features of the claimed invention except for a non-holographic or beaded screen. Both Vance and Seki teach that it was known to produce non holographic/beaded screens. It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the features as taught by Vance or Seki for the purpose of gain control.

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Allowable Subject Matter

Claim 31 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

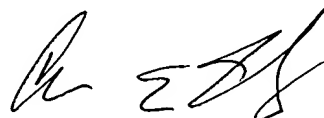
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher E Mahoney whose telephone number is (703) 305-3475. The examiner can normally be reached on 8:30AM-5PM, Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Russ Adams can be reached on (703) 308-1436. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3431 for regular communications and (703) 305-3432 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



Christopher E Mahoney
Primary Examiner
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